UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,201	02/25/2004	Fernando Incertis Carro	FR920000015US2	3700

7590 01/24/2007	
Ryan, Mason & Lewis, LLP Suite 205 1300 Post Road Fairfield, CT 06824	**EXAMINER** TRAN, QUOC A

ART UNIT	PAPER NUMBER
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

/

	Application No.	**Applicant(s)**
Office Action Summary	10/786,201	CARRO, FERNANDO INCERTIS
	Examiner	**Art Unit**	
	Tran A. Quoc	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☒ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☒ Certified copies of the priority documents have been received in Application No. <u>EP00480036.3 04-26-2000</u>.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>2-25-04</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This is a **Non-Final** rejection in response to application filed 02-25-2004.

2.   Claims 1-23 are pending in the case. Claims 1, 10, 12, 13, 20, and 23 are independent

claims.

3.   Priority dated 04-26-2000.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

5.   **Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Robinson et al., *A framework for interacting with paper*, Eurographics '97, Volume 16,

Number 3 – [www.cl.cam.ac.uk/Research/Origami/Origami1997c/index.html] (hereinafter

Robison) in view of Moran et al., US 6,326,946 B1 filed 09/17/1998 (hereinafter Moran).

Regarding independent claim 1, Robinson teaches a user system connected to a

communication network comprising one or more servers. Specifically, Robinson discloses

user interfaces for computer systems (Robinson the Abstract), and in (Robinson sections 3, 4.4

and 7).

Also, Robinson teaches **identifying a physical document, the physical document comprising one or identifying a page of the physical document.** Specifically, Robinson discloses a method of marking the paper documents with a unique identifier (Robinson Section 2-para 5).

In addition, Robinson teaches **identifying the selected marked item by referring to a hyperlink table, the hyperlink table comprising an indication of a position of each marked item on the identified page; identifying information or a service associated with the selected marked item by referring to the hyperlink table, the hyperlink table comprising, for each marked item of each page of the document, identification on a server of the information or the service associated with the selected marked item; and accessing the information or the service associated with the selected marked item.** Specifically, Robinson discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting (Robinson sections 4, 4.1, and 4.4.).

Furthermore, Robison does not teach, but Moran teaches **determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document, the identified page comprising one or more marked items, and the touch foil being pressed at a point corresponding to a selected marked item.** Specifically, Moran discloses determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in

(Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected

marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine Moran into Robinson to create the invention as claimed. It would have

been obvious and desirable to use a touch foil to locate electronically the marked positions on the

paper because the touch foil can achieve a high degree of accuracy in determining the positions

of the marks. It also would have been obvious and desirable to associate digital services with the

marks in addition to information in order to add more features to help the users draft, modify and

annotate their documents.

Regarding dependent claim 2, Robinson teaches **accessing a hyperlink table**

associated with an identified physical document (Robinson sections 4.1 and 4.4).

Regarding dependent claim 3, Robinson teaches **determining a destination address in**

the communications network where the information or service associated with the selected

marked item can be accessed (Robinson sections 4.4 and 7).

Regarding dependent claim 4, Robinson teaches **an Internet Protocol**

communications network, servers which are Web servers, a user system comprising Web

browsers, a destination address which is a Uniform Resource Locator, and that the

information or service comprises at least one Web page (Robinson sections 3, 4.4, and 7).

Robinson uses mostly commodity hardware and the registry and adaptors are written to

work as a distributed system. Commodity hardware forming a distributed system may inherently

use Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web

browsers, and information and services contained on web pages because those are all standards

of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

Regarding dependent claim 5, Robinson teaches **wherein the physical document has a form and comprises a physical surface and a material, wherein the physical surface comprises an engraved, a printed, a painted, or a written surface, wherein the material comprises paper, wood, or plastic, and wherein the form comprises a newspaper, magazine, book, catalog, geographical map, photograph, or painting.** Specifically, Robinson disclose in the abstract that the physical document comprises a physical surface made of paper on which is printed ink (Robinson the Abstract).

Regarding dependent claim 6, Robinson teaches **wherein a marked item on a physical document comprises a word, a letter, an icon, a graphic, a symbol, or a mark.** Specifically, Robinson discloses mark the paper with a reference (Robison Section 2). Moran also teaches this in the abstract.

Regarding dependent claim 7, Robinson teaches in section 4.4 that the hyperlink table comprises **additional information which may be accessed** and which may include a title, an author, and a date.

Regarding dependent claim 8, Robinson teaches in section 2 that **the physical document comprises a plurality of pages and that the identified page is one page of the plurality of pages.**

Regarding dependent claim 9, Robinson does not teach, but Moran does teach **a touch foil sensitive to pressure exercised over any point** in (Moran col. 6 lines 13-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran with Robinson to create the claimed invention. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks.

Regarding independent claim 10, the rejection of claim 1 is fully incorporated. In addition, **a user system** embodied therein for performance the method of claim 1. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract).

Also, Robinson teaches **a means for identifying a marked item by referring to a hyperlink table, identifying information associated with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item** in (Robinson section 4.1)

In addition, Robinson does not teach, but Moran teaches **a means for determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document or identifying and accessing a service associated with the selected marked item**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have

been obvious and desirable to use a touch foil to locate electronically the marked positions on the

paper because the touch foil can achieve a high degree of accuracy in determining the positions

of the marks. It also would have been obvious and desirable to associate digital services with the

marks in addition to information in order to add more features to help the users draft, modify and

annotate their documents.

Regarding dependent claim 11, Robinson teaches **a user system connected to a**

communication network comprising one or more servers in (Robinson sections 3, 4.4 and 7).

In addition, Robinson does not teach, but Moran teaches is **a transmitting means**

between the touch foil and the user system for transmitting the position of the points

pressed on the touch foil. Specifically Moran discloses a transmitting means between the touch

foil and the user system for transmitting the position of the points pressed on the touch foil in

(Moran col. 6 lines 13-34).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine Moran with Robinson to create the claimed invention. It would be

inherently necessary to create a communication link between the touch foil and the user system

for the touch foil taught by Moran to be useful.

Regarding independent claim 12, the rejection of claim 1 is fully incorporated.

In addition, **a computer program on a computer readable medium** embodied therein for

performance the method of claim 1. Specifically, Robinson discloses a high- level systems

programming language that particularly lends itself to operation in a distributed environment

(Robinson section 2).

Also, Robinson teaches **steps for identifying a marked item by referring to a hyperlink table, identifying information associated with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item** in (Robinson section 4.1).

In addition, Robinson does not teach, but Moran teaches **steps for determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document or identifying and accessing a service associated with the selected marked item**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

Regarding independent claim 13, the rejection of claim 1 is fully incorporated. In addition, Robinson teaches **storing in the hyperlink table an identification of the physical document for each page of the physical document; storing in the hyperlink table an**

identification of the identified page; storing in the hyperlink table an identification within the communication network of information or a service associated with each marked item; and storing, in the hyperlink table, positions of points corresponding to marked items, the hyperlink table comprising, for each marked item, an indication of its position on the identified page. Specifically, Robinson discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting (Robinson sections 4, 4.1, and 4.4.), and Robison discloses the registry provides the central directory service for animated paper documents. It stores the image of each active document and the code of any interactors, together with cross-references between these and indexes to identify them (Robinson section 3).

Regarding dependent claim 14, Robinson teaches in section 4.4 **storing a destination address in the communication network where information associated with a selected marked item can be accessed.**

In addition, Robinson does not teach, but Moran teaches **the service associated with a selected marked item.** Specifically, Moran discloses service associated with a selected marked item (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

Regarding dependent claim 15, Robinson teaches **an Internet Protocol communications network, servers which are Web servers, a user system comprising Web browsers, a destination address which is a Uniform Resource Locator, and that the information or service comprises at least one Web page** in (Robinson sections 3, 4.4, and 7). Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system inherently uses Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

Regarding dependent claim 16, Robinson teaches **wherein the physical document has a form and comprises a physical surface and a material, wherein the physical surface comprises an engraved, a printed, a painted, or a written surface, wherein the material comprises paper, wood, or plastic, and wherein the form comprises a newspaper, magazine, book, catalog, geographical map, photograph, or painting.** Specifically, Robinson disclose in the abstract that the physical document comprises a physical surface made of paper on which is printed ink (Robinson the Abstract).

Regarding dependent claim 17, Robinson teaches **wherein a marked item on a physical document comprises a word, a letter, an icon, a graphic, a symbol, or a mark.** Specifically, Robinson discloses mark the paper with a reference (Robison Section 2). Moran also teaches this in the abstract.

Regarding dependent claim 18, Robinson teaches **storing in the hyperlink table additional information related document, the additional information comprising a title, an author, and a date**. For example, Robison discloses the registry provides the central directory service for animated paper documents. It stores the image of each active document and the code of any interactors, together with cross-references between these and indexes to identify them (Robinson section 3).

Regarding dependent claim 19, Robinson teaches in the abstract and section 2 that **the physical document comprises a plurality of pages and wherein the identified page is one page of the plurality of pages**.

Regarding independent claim 20, the rejection of claim 13 is fully incorporated. In addition, **a user system** embodied therein for performance the method of claim 13. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract).

Regarding independent claim 21, Robinson teaches **the user system is connected to a communication network comprising one or a plurality of servers** (Robinson sections 3, 4.4, and 7). Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system may inherently use Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

In addition, Robinson does not teach, but Moran teaches s **a transmitting means between the touch foil and the user system for transmitting the position of the points**

pressed on the touch foil. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

Regarding dependent claim 22, Robinson does not teach, but Moran teaches s **a wherein the touch foil comprises a transparent touch foil, the touch foil being placed and aligned over the identified page of the physical document**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-14) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3). It would be inherently necessary to create a communication link between the touch foil and the user system for the touch foil taught by Moran to be useful.

Regarding independent claim 23, the rejection of claim 13 is fully incorporated. In addition, **a computer program stored on a computer readable medium** embodied therein for performance the method of claim 13. Specifically, Robinson discloses user interfaces for

computer systems (Robinson the Abstract), and Robinson discloses a high- level systems

programming language that particularly lends itself to operation in a distributed environment

(Robinson section 2).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Schena et al   US 6,448,979   issued 09 -2002

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The

examiner can normally be reached on 9AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Herndon R. Heather can be reached on 571-272-4136. The fax phone number for the

organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran - 1-19-2007
GAU 2176

H. Herndon
Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100